

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. MILLER,
DAVID R. SCHWARTZ
and RODNEY A. SMITH

Appeal No. 1997-4354
Application 08/177,296

ON BRIEF

Before URYNOWICZ, KRASS and DIXON, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

Decision on Appeal

This appeal is from the final rejection of claims 1-3, 5-10 and 12-22, all the claims pending in the application.

The invention pertains to a method and apparatus for customizing a graphical user interface. Claims 1 and 15 are illustrative and read as follows:

1. A method in a data processing system having a display for graphically modifying functions and/or features of a graphical user interface having at least one graphical user interface element associated therewith, said method comprising the steps of:

displaying a graphical user interface element within a window within said display;

temporarily removing said graphical user interface element from said window in preparation for modifying an area of said window coextensive with said graphical user interface element;

designating a selected area within the coextensive area within said window;

displaying a user-selected representation of a desired function and/or feature within said selected area within said window in response to said designation of said selected area;

restoring said graphical user interface element to said window; and

thereafter displaying said user-selected representation within said selected area within said graphical user interface element of said window whenever said window is open, wherein a user may graphically modify functions and/or features associated with said graphical user interface.

15. Computer readable code for permitting a user to customize a structural non-content portion of an element of a graphical user interface by adding an optional function/feature to, or deleting an optional function/feature from, the portion of the element, comprising:

first subprocesses for permitting a user to select a portion of an element of a graphical user interface for customization;

second subprocesses for permitting the user to select a first function/feature to be added to the portion of the element from a set of optional features/functions;

third subprocesses for permitting the user to place the selected function/feature at a user desired position for display within the portion of the element; and

fourth subprocesses for permitting the user to delete a second function/feature from the portion of the element upon designation of the second function/feature.

The reference relied upon by the examiner is:

Appeal No. 1997-4354
Application 08/177,296

A summary of Diefendorff's teaching appears at column 5, lines 9-31, of the patent.

Opinion

We will consider the rejection under the second paragraph of § 112 first. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The inquiry to be made concerning the second paragraph of 35 U.S.C. § 112 is to determine whether the claims set out and circumscribe a particular area with a reasonable degree of precision, and particularly when read by the artisan in light of the disclosure and the relevant prior art. In re Moore, supra. The examiner's position is to the effect that appellants' use of the term "permitting" before each function of the sole independent claim 15 of the group consisting of claims 15-21 renders the claims indefinite because no function actually occurs.

We are not persuaded by the examiner's position. It is evident that the term "permitting" followed by a function in each instance defines what property or capability each subprocess of

claim 15 must have. It was the examiner's burden to find in the prior art the existence of processes capable of performing the respective functions. Accordingly, we will not sustain the rejection of claims 15-21 under 35 U.S.C. § 112, second paragraph.

We will not sustain the rejection of claims 15-21 under 35 U.S.C. § 101 on the ground that they are directed to subprocesses, which constitute non-statutory subject matter.

The examiner's position appears to be that subprocesses are abstract ideas and that such ideas are excluded from patent protection. However, ideas are not abstract if they are reduced to a practical application. State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998). Here, the practical application is as recited in the preamble of claim 15, which is "to customize a structural non-content portion of an element of a graphical user interface".

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that the rejection of claims 15, 20 and 21 under 35 U.S.C. § 102 over Diefendorff should be sustained but that the rejection of claims

16-19 over Diefendorff on the same statutory ground should not be sustained. With respect to the first three subprocesses of independent claim 15, the reference teaches at column 5, lines 9-31, selection of a portion 16 of an element of a graphical user interface 12 (Figure 1) for customization, selection of a function/feature

from window 14 to be added to the portion 16 of the graphical user interface element 12, and placing the selected function/feature from window 14 in portion 16. With respect to the fourth and last recitation of claim 15, at column 9, lines 58-68, Diefendorff teaches deleting a second function/feature (in a porthole) from a portion 16

of the element. With respect to dependent claim 20, the reference discloses modifying the position of a function/feature at column 6, lines 45-59, in that movement of a porthole to a new location is described. As to dependent claim 21, Diefendorff teaches that element 12 is a window.

With respect to dependent claim 16, the examiner relies on Diefendorff's teaching at column 6, lines 47-50, that a porthole 16 can be moved to a new location in window 12 to establish the claim limitation to the effect that the portion (porthole) is

removed from the element (window 12) upon selection of the portion. We are not persuaded that the above teaching of the reference meets the claim limitation. Moving an object or thing in an element is not the same as removing it from the element.

Whereas we will not sustain the rejection of claim 16 as anticipated by Diefendorff for the above reason, we will not sustain the rejection of claims 17 and 19, which depend therefrom, on the same statutory ground.

We will not sustain the rejection of claim 18, which depends directly from claim 15, as anticipated by Diefendorff. This claim relates to a user manipulable button within the portion. Diefendorff has no teaching of such a button within portion 16.

We have concluded that the rejection of independent claims 1 and 8 as anticipated by Diefendorff should not be sustained. Starting with the first recitation of the body of claim 1, the examiner contends the limitations of the claim are met as follows.

Window 12 of Figure 1 of the reference is the graphical user interface element and window 14 is the window. The interface element 12 is temporarily removed from the window 14 when window 14 is brought to the top of the display. A selected area within

window 14 is designated when a pointer is used to define a porthole area therein (column 5, lines 14-22). A representation of a desired feature within the selected area of window 14 is displayed in porthole 16 and the graphical user interface element 12 is restored when it is brought back to the top of the display. We agree with the examiner that the above subject matter of the claim is anticipated by Diefendorff.

However, the last paragraph of claim 1 requires "displaying said user-selected representation within said selected area within said graphical user interface element of said window whenever said window is open". The reference does not meet this recitation because it is not established that the user-selected representation in porthole 16 is disclosed as displayed within element 12 whenever said window is open. The disclosure at column 5, lines 25-27, of Diefendorff which is relied on by the examiner to meet this limitation does not establish that the user-selected representation is displayed more than once and the examiner has provided no rationale why the display of the type claimed would occur whenever window 14 is opened.

Furthermore, one would expect that window 14 of Diefendorff would be displayed without graphical user interface element 12 in the ordinary course of computer usage and, thus, the user-selected representation would not be displayed within a graphical user interface element 12 in that case.

Claim 8 requires means for displaying said user-selected representation within said graphical user interface element whenever said graphical user interface element is displayed. This requirement is not met in Diefendorff essentially for the reasons that the corresponding limitation in claim 1, considered above, is not met. It is not established that a user-selected representation is displayed within element 12 whenever the element is displayed. In fact, Diefendorff teaches away from such a function in that the reference teaches at column 1, lines 32-34, "Sometimes it is desirable for an operator to be able to observe a part of a particular window which is otherwise covered."

Claim 8 is not rejected as obvious over Diefendorff and the examiner has provided no rationale why one of ordinary skill in the art would have modified the teachings of the reference to provide the above means for displaying.

Appeal No. 1997-4354
Application 08/177,296

Whereas we will not sustain the rejection of independent claims 1 and 8, we will not sustain the rejection of claims 2, 3 and 5-7, which depend from claim 1, or of claims 9, 10, 12-14 and 22, which depend from claim 8, as anticipated by or obvious over Diefendorff.

Summary

The rejection of claims 15-21 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claims 15-21 under 35 U.S.C. § 101 is reversed.

The rejection of claims 15, 20 and 21 under 35 U.S.C. § 102(b) as anticipated by Diefendorff is affirmed.

The rejection of claims 1-3, 5, 8-10, 12, 16-19 and 22 under 35 U.S.C. § 102(b) as anticipated by Diefendorff is reversed.

The rejection of claims 6, 7, 13 and 14 under 35 U.S.C. § 103 as being unpatentable over Diefendorff is reversed.

Appeal No. 1997-4354
Application 08/177,296

No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

STANLEY M. URYNOWICZ)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

Appeal No. 1997-4354
Application 08/177,296

SMU/kis

INTELLECTUAL PROPERTY LAW DEPT.
IBM Corporation
T81B/Bldg. 062/B109
3039 Cornwallis Road
Research Triangle Park, NC 27701-2195